

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Joseph DA CRUZ
Application No.: 10/573,986
35 U.S.C. § 371 Date: September 6, 2006
U.S. National Stage of: PCT/AU2004/001296
PCT Filing Date: September 22, 2004
For: DENTAL APPLIANCE
Group Art Unit: 3732
Confirmation No.: 1795
Examiner: Hao D. Mai

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REQUEST FOR INDICATION OF CONSIDERATION OF
REFERENCES ON ACCOMPANYING FORM PTO/SB/08a**

Sir:

In accordance with 37 C.F.R. § 1.56 and MPEP § 714.16, Applicant respectfully submits the accompanying Form PTO/SB/08a and requests that the references listed thereon be indicated as considered by the Examiner such that they will be listed on the patent to issue from this application.

The basis for this request is as follows.

This application is a U.S. National Stage application of PCT application PCT/AU2004/001296. In that PCT application, an International Search Report (“ISR”) was mailed on October 26, 2004, and an International Preliminary Report on Patentability (or International Preliminary Examination, “IPE”) was mailed on December 21, 2005. Copies of the ISR and ISE were submitted with this U.S. National Stage application. See Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495, mailed December 6, 2006.

The ISR and ISE listed the following six (6) references:

- (1) JP 2002191623 A (ASO INTERNATIONAL);
- (2) US 4,299,568 (CROWLEY);
- (3) US 3,967,379 (BERGERSEN);
- (4) US 4,253,828 (COLES et al);
- (5) US 5,376,001 (TEPPER); and
- (6) US 5,607,300 (TEPPER).

In the Image File Wrapper (“IFW”) available in PAIR, the “Examiner’s search and strategy results” (Mail Room Date 7/29/09) lists all six (6) of the above references, indicating that the references from the ISR and ISE were indeed considered by the Examiner during the U.S. National Stage. This is in accordance with desired procedure, as indicated in the MPEP. See MPEP § 1893.03(g) (“It is desirable for the U.S. examiner to consider the documents cited in the international application when examining the U.S. national stage application ...”).

While the “Examiner’s search and strategy results” indicates that all six (6) references were considered, only two of those references—namely, US 4,299,568 (CROWLEY) and US 5,607,300 (TEPPER)—were listed on a PTO-892 form. See PTO-892 form attached to 4/14/09 Office Action.

The Applicant would like to respectfully request that the Examiner indicate that the remaining four (4) references from the ISR have been considered on the accompanying Form PTO/SB/08a, to insure that all of the references from the ISR are listed on the patent to issue from this application. Accordingly, the Applicant respectfully submits the accompanying Form PTO/SB/08a, along with a copy of JP 2002191623 A (ASO INTERNATIONAL).

This Form PTO/SB/08a is being filed after the mailing date of a Notice of Allowance, but before payment of the Issue Fee. Accordingly, please debit Deposit Account No. 11-0600 in the amount of \$180.00 in payment of the petition fee under 37 CFR §1.17(p).

Because all of the references listed in the attached Form PTO/SB/08a were listed in the ISR that was issued in PCT application PCT/AU2004/001296, because that ISR accompanied entry of this application into the U.S. National Stage, and because it appears from the “Examiner’s search and strategy results” (Mail Room Date 7/29/09) that all of these references have already been considered by the Examiner, it is believed that no certification is necessary.

Should any issue arise, the Examiner is invited and encouraged to contact the undersigned at the number given below.

The filing of the accompanying Form PTO/SB/08a shall not be construed as an admission that the information cited is prior art, nor that it is considered to be material to patentability as defined in 37 C.F.R. § 1.56(b).

It is believed that no fees other than the fee indicated above are due, but authorization is hereby given to charge any additional fees due, or to credit any overpayment, to Deposit Account 11-0600.

Respectfully submitted,

Date: August 6, 2009

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